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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/074,070	02/12/2002	Rajesh Kumar Varma	GLS-021	6677

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EXAMINER

MULLIS, JEFFREY C

ART UNIT

PAPER NUMBER

1711

DATE MAILED: 04/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No. 10/074,070	Applicant(s) VARMA, RAJESH KUMAR	
	Examiner Jeffrey C. Mullis	Art Unit 1711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 February 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 and 13-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 and 13-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit 1711

All remaining rejections and/or objections follow.

Claims 1-11 and 13-24 are rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The amendment filed 1-2-04 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure.

35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

The material at page 13 in which it is recited that polyisobutene oil is replaced with the same amount of mineral oil. While it is clear that the specification as filed contained an error in that replacing polyisobutene oil or polybutene oil for that matter with polyisobutene oil makes no sense. There is nothing in the specification as filed which would indicate that mineral oil was used. This information is therefore new matter.

Applicant's amendment to Table 2 on page 23 adding a zero to the oxygen permeation is also new matter in that there is no way that those of ordinary skill in the art when viewing applicant's specification as filed would conclude that the oxygen permeation

values are off by a factor of 10.

An oxygen permeability of less than 20,000 is not disclosed by the specification as filed and this limitation is therefore new matter.

The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-11 and 13-24 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Baranowski et al. (WO 02/14171).

Baranowski et al. disclose a closure cap for beverage bottles (page 4 lines 20-25) which may contain a polybutene "PB 400" at page 9 lines 28-36 and a SEBS block copolymer at page 9 lines 1-8 in applicant's amounts at page 10 lines 25-30. The block copolymer may be replaced by a thermoplastic olefin with a cross-link rubber (i.e. vulcanized) at page 8 lines 2-11. Note that patentees disclose at page 13 line 9 an oxygen permeability rate although no thickness for the measurement is disclosed. Nonetheless the thickness of a liner is on the order of

millimeters within microns as recited by the instant claims and it would reasonably appear that patentees' oxygen permeability rate would therefore be on the order of a thousand times higher when expressed as micron thicknesses rather than millimeter thicknesses and would fall within the metes and bounds of the claims. In any case, manipulation of oxygen permeability would have been obvious to a practitioner having ordinary skill in the art at the time of the invention given that minimization of oxygen permeability is taught to be desirable by Baranowski in that it only requires routine experimentation to find an optimum or workable range of a result effective variable absent any showing of surprising or unexpected results. With regard to applicant's hardnesses, patentees specifically disclose that low hardness is undesirable and therefore implies that hardness is a result effective variable also and therefore choice of applicant's hardnesses would have been obvious to a practitioner having ordinary skill in the art at the time of the invention in that it requires routine experimentation to find the optimal or workable range of a result effective variable absent any showing of surprising or unexpected results.

It is noted that the newly rejected claims over Baranowski do not have the word "detackified" and are therefore no longer allowable over Baranowski et al.

Art Unit 1711

Applicant is required to cancel the new matter in the response to this Office action.

With regard to applicant's Declaration, applicant's definitions are accepted. With regard to applicant's amendment to Table 2 discussed in applicant's Declaration, there is nothing in Table 2 as filed to indicate that an error was present or what the correction should be.

Applicant's arguments filed 1-2-04 and 2-2-04 have been fully considered but they are not deemed to be persuasive.

It is true that the denial of a filing date cannot be based on the fact that the parent provisional case is only a few pages long alone. However the fact that the provisional parent is only a few pages long is not the only reason why it is the position of the Examiner that applicant's claims are not supported by the parent provisional application. Applicant argues that a composition containing a number of materials embraced by the claims having molecular weights embraced by the claims are disclosed by the provisional application. However in order for a claim to be awarded the filing date of the provisional application, the full breadth of the claims must be supported by the provisional application. Unfortunately, a single species does not support a genus such as in the instant case a vinyl aromatic-polyolefin polyblock copolymer is not supported by the

use of Kraton G1651, applicant's molecular weight ranges are not supported by the disclosure of a material having a molecular weight within the range, applicant's hardness values are not supported by a material having a single hardness value etc.

With regard to the former rejections under 35 U.S.C. § 112, second paragraph, the Examiner accepts applicant's definitions.

With regard to Baranowski et al., applicant's remarks regarding the rejection under 35 U.S.C. § 102 are moot since this rejection has been withdrawn.

With regard to applicant's argument that Baranowski's polyisobutene is not an oil, the Examiner does not agree. While it is true that Baranowski et al. discloses that prior art materials encounter problems due to liquid plasticizers, Baranowski in Example 1 implies that patentees overcome this problem by use of a liner. Note also page 11 lines 16-21 which implies that polyisobutene leads to increased softness. Therefore it would appear that the polyisobutene is a liquid since it confers the property of softness. Applicant argues that Baranowski gives no further details about the ingredients they found operable or the ranges in which those ingredients are operable. However only a single embodiment is needed to render a claim obvious. Therefore no ranges of concentrations are necessary but rather only a single concentration falling within

Serial No. 10/074,070

-7-

Art Unit 1711

the scope of the claims. It is enough that Baranowski discloses the various components used in their composition since those skilled in the art understand how to blend various materials. The disclosure of blending by patentees is sufficient to enable the disclosure of Baranowski. It is noted that Baranowski at column 11 lines 29-31 specifically disclose the use of extrusion and give specific details about mixing. There is therefore ample detail in Baranowski as to how to form their composition.

Applicant's amendment necessitated the new grounds of rejection. Accordingly, **THIS ACTION IS MADE FINAL**. See M.P.E.P. § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM

Serial No. 10/074,070

-8-

Art Unit 1711

THE DATE OF THIS FINAL ACTION.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey Mullis whose telephone number is (571) 272-1075. The examiner can normally be reached on Monday-Friday from 9:30 to 6:30.

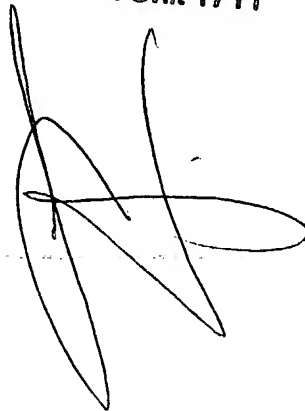
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck, can be reached on (571) 272-1078. The fax phone number for this Group is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-0994.

J. Mullis:cdc

April 20, 2004

Jeffrey Mullis
Primary Examiner
Art Unit 1711

A handwritten signature in black ink, consisting of a large, stylized 'J' followed by a series of loops and a final horizontal stroke.